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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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11/14/2003

Eric Garland

34443.3

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06/29/2006

BLAKELY SOKOLOFF TAYLOR & ZAFMAN
12400 WILSHIRE BOULEVARD
SEVENTH FLOOR
LOS ANGELES, CA 90025-1030

EXAMINER

ROBINSON, GRETA LEE

ART UNIT

PAPER NUMBER

2168

DATE MAILED: 06/29/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/714,283	Applicant(s) GARLAND ET AL.	
	Examiner Greta L. Robinson	Art Unit 2168	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) 1-8, 17-23 and 31-34 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9-16, 24-30 and 35-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 November 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-38 are pending in the present application. Claims 1-8, 17-23 and 31-34 have status withdrawn. Claims 9 and 24 were amended in the response filed April 11, 2005.

Drawings

2. The drawings are objected to because of they depict partial views. See 37 CFR 1.184(h). For example, note Figure 1, element 180 is not shown as coupled to element 190 or 100. Also note Figure 2 elements 180 and 226, Figure 4 elements 480a and 420, Figure 9 element 982, Figure 10 element 1026 and 982, Figure 12 element 1282a and 1250, Figures 13 and 18. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are

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not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

3. INFORMATION ON HOW TO EFFECT DRAWING CHANGES

Replacement Drawing Sheets

Drawing changes must be made by presenting replacement sheets which incorporate the desired changes and which comply with 37 CFR 1.84. An explanation of the changes made must be presented either in the drawing amendments section, or remarks, section of the amendment paper. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). A replacement sheet must include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of the amended drawing(s) must not be labeled as "amended." If the changes to the drawing figure(s) are not accepted by the examiner, applicant will be notified of any required corrective action in the next Office action. No further drawing submission will be required, unless applicant is notified.

Identifying indicia, if provided, should include the title of the invention, inventor's name, and application number, or docket number (if any) if an application number has not been assigned to the application. If this information is provided, it must be placed on the front of each sheet and within the top margin.

Annotated Drawing Sheets

A marked-up copy of any amended drawing figure, including annotations indicating the changes made, may be submitted or required by the examiner. The annotated drawing sheet(s) must be clearly labeled as "Annotated Sheet" and must be presented in the amendment or remarks section that explains the change(s) to the drawings.

Timing of Corrections

Applicant is required to submit acceptable corrected drawings within the time period set in the Office action. See 37 CFR 1.85(a). Failure to take corrective action within the set period will result in ABANDONMENT of the application.

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If corrected drawings are required in a Notice of Allowability (PTOL-37), the new drawings **MUST** be filed within the **THREE MONTH** shortened statutory period set for reply in the "Notice of Allowability." Extensions of time may **NOT** be obtained under the provisions of 37 CFR 1.136 for filing the corrected drawings after the mailing of a Notice of Allowability.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 9-16 and 24-30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding independent claims 9 and 24 the following phrase is vague and not clear: "without any action required from any user of the plurality of computers" [note: see claim 9 line 8-10; claim 24 line 9-10]. Claims 10-16 and 25-30 are rejected based on dependency.

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 37 and 38 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. As present written claims 37 and

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38 are directed to an abstract idea in which a concrete, useful tangible result does not occur. The claim simply presents various structures such as "query computer", "monitor computer" and "database". The claim does not recite a functional tangible result for each cited structure.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 35 and 37 are rejected under 35 U.S.C. 102(e) as being anticipated by Pearson US Patent Application Publication No. 2003/0028610 A1.

Regarding claim 35, **Pearson** teaches a method comprising:

establishing a connection to a plurality of computers [note: paragraph 0027

Internet Protocol; Figures 3 and 4];

requesting a list of files shared by each of the plurality of computers [note: Figure

6];

obtaining from each of the plurality of computers the list of files shared by that computer [note: Figure 7]; and

storing the obtained plurality of lists of shared files in a database [note: Figure 7 step(190); abstract; paragraph 0046 and 0049-0053].

Regarding claim 37, Pearson teaches a query computer coupled to a network to issue a query to a plurality of peer-to-peer network [note querying host 102];

a monitor computer coupled to the network to block the download request from the query computer [note: get user's choice of file download step 128 Figure 5; paragraph 029 note protocol module]; and a database to store a copy of the download request [Figure 7 step 190].

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

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not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

11. Claims 9-12, 15-16 and 24-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dutta et al. US Patent Application Publication No. 2002/0138471 A1 in view of Nair.

As per independent claim 9 Dutta teaches:

a computer coupled to the network at fig.4, paragraph 70;

a database coupled to the computer at fig.4, paragraph 70 (client rating database);

a query device adapted to request a list of shared files from a plurality of computers connected to the network at paragraph 59, lines 1-4;

and a transfer device adapted to transfer the a list of shared files from each computer of the plurality of computers and store the list of shared files in the database at paragraph 60, lines 1-4, also note *shared file list* 264 paragraph 0041.

Dutta does not explicitly teach transferring passively and without any action required from any users of the plurality of computers however Nair does teach this limitation at parg.9.

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the cited references to make it simple to find and exchange files (parg. 9, lines 16-17). Also because Nair teaches the peer-to-peer network provides for anonymous transfer of files.

As per claim 10 same as claim arguments above and Dutta teaches: further comprising an inventory preparation server coupled to the database at paragraph 71(client ratings database) and parg. 77, lines 11-13, rating server.

As per claim 11 same as claim arguments above and Dutta teaches:
further comprising an archiving system coupled to the database, the archiving system to store at least one copy of the plurality of lists at paragraph 71(client ratings database).

As per claim 12 same as claim arguments above and Dutta teaches:
further comprising an inventory processing server coupled to the database at paragraph 71.

As per claim 15 same as claim arguments above and Dutta teaches:
the computer further comprising an interception device adapted to make a copy of a plurality of search requests from the network at paragraph 59.

As per claim 16 same as claim arguments above and Dutta teaches:
the computer further comprising a second transfer device adapted to transfer the plurality of search requests from the computer to the database at paragraph 59.

As per independent claim 24 Dutta teaches:
coupling a computer to a database at fig.4, paragraph 70;
coupling the computer to the network at fig.4, paragraph 70 (client rating database); locating a plurality of computers connected to the network by IP address at paragraph 71, lines 4-5;
requesting a listing of a library of shared files from each of said plurality of computers connected to the network at paragraph 59, lines 1-4;
passively transferring the listing of the plurality of libraries of shared files from the computer to the database ... at paragraph 60, lines 1-4 and paragraph 0041.

Dutta does not explicitly teach passively and without any action required from any users of the plurality of computers however Nair does teach this limitation at parg.9. It would have been obvious to one of ordinary skill in the art at the tie of the invention to combine the cited references to make it simple to find and exchange files (parg. 9, lines 16-17).

As per claim 25 same as claim arguments above and Dutta teaches:
further comprising adding source information to each of the listings at paragraph 71. As per claim 26 same as claim arguments above and Dutta teaches:
wherein the source information comprises the geographic location of a computer where the library is stored at paragraph 71.

As per claim 27 same as claim arguments above and Dutta teaches:
further comprising intercepting a plurality of search requests on the network, where said plurality of search requests come to said computer, and copying said plurality of search requests at paragraph 59.

As per claim 28 same as claim arguments above and Dutta teaches:
further comprising transferring the plurality of search requests from the computer to the database at paragraph 59.

12. Claims 13-14 and 29-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dutta et al (Pub. No.: US 2002/0138471) and Nair (US 2004/0193900) in view of O'Kane (Pub. No.: US 2003/0105831).

As per claim 13-14 same as claim arguments above and Dutta teaches: further comprising an inventory preparation server coupled to the database, an inventory

processing server coupled to the inventory preparation server at fig.4. Dutta and Nair do not explicitly teach a report preparation server coupled to the inventory processing server however O'Kane teaches this limitation at paragraph 62, lines 1-6 and paragraph 63. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the cited references to allow intellectual property owners a means to track royalties at paragraph 19, lines 1-4.

As per claim 29-30 same as claim arguments above and Dutta and Nair do not explicitly teach generating at least one report including data from a plurality of listings and a plurality of search requests however O'Kane teaches this limitation at paragraph 62, lines 1-6 and paragraph 63. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the cited references to allow intellectual property owners a means to track royalties at paragraph 19, lines 1-4.

13. Claims 36 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pearson US Patent Application Publication No. 2003/0028610 A1 in view of O'Kane (Pub. No.: US 2003/0105831).

As per claims 36 and 38 Pearson do not explicitly teach:
an inventory processing computer coupled to the database to add information to the copy of the download request in the database and a report generation to prepare a report based on information in the database. O'Kane does teach this at parg. 62-63. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the cited references because it would provide a means of analysis to the end use and tracking data.

Response to Arguments

14. Applicant's arguments filed April 11, 2006 have been fully considered but they are not persuasive.

Applicant's arguments with respect to claims 35-38 have been considered but are moot in view of the new ground(s) of rejection.

In the response Applicant argued (1) regarding independent claims 9 and 24 the prior art does not teach a list of stored files are stored in a database. (2) Regarding independent claims 35 and 37 the examiner stated that Dutta does not teach peer-to-peer network, however the primary reference does teach this limitation.

In response to argument (1) note Dutta teaches an alternative (264) list of shared files which may be imported and exported see paragraph 0041 and Figure 2C sharable file list element 264. Applicants arguments regarding claims 35-38 are moot in view of the new grounds of rejection. Note newly cited reference Pearson supra.

Conclusion

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.


Schieicher et al. US Patent Application Publication 2002/0138744 A1

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16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Greta L. Robinson whose telephone number is (571)272-4118. The examiner can normally be reached on M-F 9:30AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tim T. Vo can be reached on (571)272-3642. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



GRETAL ROBINSON
PRIMARY EXAMINER

Greta Robinson
Primary Examiner
June 23, 2006